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EXAMINER

AUGUSTINE, NICHOLAS

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. TORRES, THOMAS M. LANZETTA and
FITZGERALD STEELE JR.

Appeal 2009-002730
Application 10/692,140
Technology Center 2100

Before JOSEPH L. DIXON, JAY P. LUCAS, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

According to Appellants, the invention relates to “a methodology and implementation for facilitating electronic information input to computer systems” (Spec. 1: 10-12).

Claim 1 is illustrative:

1. A method for facilitating input of information by a user into a form displayed on a display device, said form being arranged for receiving said input into one or more input fields of said form, said method comprising:

determining when a displayed cursor is positioned within a predetermined area relative to a first input field;

accessing a data file containing a first extended information, said first extended information containing information related to said first input field;

displaying said first extended information in a first position on said display device; and

enabling said user to change a location on said display device for said first position.

Rejections

^ R1: Claims 1-6, 12-16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ko (US 7,024,626 B2, Apr. 4, 2006) and Carroll (US 6,762,777 B2, Jul. 13, 2004).

R2: Claims 7-11 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ko, Carroll and Garland (US 6,252,596 B1, Jun. 26, 2001).

R3: Claims 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ko, Carroll, Garland, and Card (US 6,924,822 B2, Aug. 2, 2005).

GROUPING OF CLAIMS

Appellants argue claims 1-20 as a group on the basis of claim 1 (Br. 14-21). Appellants argue the rejection of claims 7-11 and 18, based on arguments made with respect to independent claims 1, 16, and 17 (*see* Br. 18-19). Appellants argue the rejection of claims 19-20 based on arguments made with respect to claim 18 (*see* Br. 19-20). Appellants argue the rejection of claims 2-6 and 12-15 based on arguments made with respect to claim 1 (*see* Br. 20-21). We select independent claim 1 as the representative claim. We will, therefore, treat claims 2-20 as standing or falling with representative claim 1.

FINDINGS OF FACT (FF)

Appellants' Specification

1. Appellants' Specification discloses: "In the present disclosure, the terms 'extended information', 'extended text' and 'guidance text' are used interchangeably to refer to predetermined text strings which are associated with each of the fields in a displayed form." (page 8, ll. 25-28).

Ko Reference

2a. Ko discloses that "After determining a target in step 508, a notification object is generated at step 510. This notification object is then displayed, as described above, so that it points to or otherwise identifies the target that was determined in step 508." (col. 7, ll. 6-10).

2b. Ko discloses:

The notification objects described herein may also be used in connection with various other objects, such as user input elements contained within window. For example, text fields ... may be the target of notification objects, which may be triggered by a user action of entering or editing data in such elements" (col. 7, ll. 11-16).

2c. Ko discloses "FIGS. 2, 3 and 4 use[] the notification object to indicate that a password must be submitted ...; however, other types of warning information may be displayed." (see col. 7, ll. 24-27; see also FIGS. 3 and 4).

2d. Ko discloses:

Two data entry fields 210, 212 are provided for the entry of a computer name and password, respectively. Once this information has been entered, the user proceeds with the operating system set up procedure by clicking ... to advance to

the next page of the setup information If, however, the user neglects to enter text in one of the data entry fields 210, 212 when text is required in these fields, and attempts to advance to the subsequent setup page, an error message is generated.” (col. 4, ll. 23-26; see also FIG. 2).

Carroll Reference

3. Carroll discloses

The invention ... relates to a system and method for associating popup windows with selected regions of a document. The invention permits a user to take a highlighted or otherwise selected region within an electronic document and append or attach a popup window with embedded information This is accomplished in part by employing freely moveable popup delimiter tags, which can be positioned and repositioned within a document to highlight the enclosed information and associate with that information a popup message, graphic or other information.” (*see* col. 1, ll. 36-47).

PRINCIPLES OF LAW

Claim Construction

Claims must "particularly point out . . . the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, second paragraph.

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’”

In re Bigio, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). During patent examination, claims are given their broadest reasonable interpretation in light of the specification as it would be interpreted by skilled artisans. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (citations omitted).

Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). If the Examiner's burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

Claims 1-20

Issue 1: Did the Examiner err in finding that the prior art teaches or suggests “displaying said first extended information in a first position on said display device”; and “enabling said user to change a location on said display device for said first position,” as set forth in claim 1.

Appellants argue that “the Ko reference teaches a system and method of producing user interface information messages but does not disclose or even suggest enabling a user to select and/or move the location of the information message relative to an information input field” (Br. 16). Further, Appellants argue that “Carroll is similar to Ko in that there is no disclosure or suggestion of enabling a user to change a location of an extended information window relative to an input field of a fill-in form” (*id.* at 17). Appellants contend that “Carroll discloses only changing a text section which will be used to activate a pop-up window” and “[t]he location

of the pop-up window ... in that case is fixed or predetermined relative to the text within the delimiter tags and this location cannot be changed as taught by the present invention” (*id.*).

The Examiner finds that “Carroll ... teaches enabling said user to change a location on said display device for said first position” (Ans. 5). We agree.

In Appellants’ Specification, the term “extended information” refers to “predetermined text strings which are associated with each of the fields in a displayed form” (FF 1). Similarly, Ko’s notification object includes text warning information which points to or otherwise identifies (*i.e.*, is associated with) a target. Furthermore, in Ko, an example of a target is a user input element contained within a window, such as a text field or form (FFs 2b and 2d).

Thus, we find that the claimed “first extended information” reads on Ko’s notification object. As Ko explicitly discloses displaying “a notification object” (FF 2a), we find that Ko further discloses “displaying said first extended information in a first position on said display device,” as recited in claim 1.

While the Examiner relies on Ko for teaching the first extended information and the displaying of first extended information, the Examiner, however, relies on Carroll for teaching enabling a user to change a location on said display device for said first position (*see* Br. 4-5). Carroll teaches “freely moveable popup delimiter tags, which can be positioned and repositioned within a document to highlight the enclosed information and associate with that information a popup message, graphic or other information” (FF 3). In other words, Carroll discloses enabling a user to

change the location of text information on a display. Thus, we find that the combination of Ko and Carroll discloses “displaying said first extended information in a first position on the display device, and enabling said user to change a location on said display device for said first position,” as set forth in claim 1.

Issue 2: Did the Examiner err in combining Ko and Carroll?

Appellants contend that “Ko does not ... recognize or address the problem solved by the present invention and therefore cannot be said to suggest a combination with Carroll to render the present invention obvious” (Br. 16).

We point out to Appellants that for a *prima facie* case of obviousness to be established, the reference need not recognize the problem solved by the Appellants. *See In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996); *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992); *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Int. 1985) (“The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.”)

Furthermore, there is no requirement that any problem solved by the secondary reference be discussed by the primary reference to apply the teachings of the secondary reference in a rejection under 35 U.S.C. § 103. The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider “the background knowledge possessed by a person having ordinary skill in

the art” and “the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions,” and the basis for an obviousness rejection must include an “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*

The Examiner has found actual teachings in the prior art and has provided a rationale for the combination. Specifically, as noted *supra* the Examiner finds that Ko discloses displaying “extended information” and that Carroll discloses changing a location of displayed information and that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ko by enabling said user to change a location on said display device for said first position as taught by Carroll in order to enable the user to freely change a location on the document to insert editable popup windows making the document flexible to the user” (Ans. 5).

Such teachings suggest that the combination involves the predictable use of prior art elements according to their established functions. Accordingly, we find that the Examiner has provided sufficient motivation for modifying Ko with the teachings of Carroll, and we will therefore sustain the obviousness rejection of claims 1-20, for at least the reasons noted above.

DECISION

The Examiner’s rejection of claims 1-20 under 35 U.S.C. § 103(a) is affirmed.

Appeal 2009-002730
Application 10/692,140

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

APJ INITIALS:

ke

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